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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,592	11/21/2003	Eva J. Tsai	Tsai	9389
7590 06/29/2004			EXAMINER	
John P. Sutton 2421 Pierce Street San Francisco, CA 94115			GONZALEZ, MADELINE	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/717,592

Applicant(s)

TSAI, EVA J.

Examiner

Madeline Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 3-5 is objected to because of the following informalities:
  - a) Claim 3: The claim recites the limitation “ the measuring points” in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
  - b) Claim 4: The claim recites the limitation “ the measuring point” in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
  - c) Claim 5: “a” in line 4 should be replaced with --at--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogler (U.S. 5,465,501).

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Rogler discloses a gage 36, as shown in Fig. 2, having:

- two jaws 26, 30 appended from a beam 22 capable of indicating distance between the jaws 26, 30, characterized in that stops 26d-26g, 30d-30g, movable between at least two limits permit the jaws 26, 30 to measure distance at the at least two limit positions perpendicular to and equidistant from the beam 22; and
- wherein the gage 36 measures the inside diameter of a generally cylindrical surface along at least two points precisely the same distance from the end of the cylindrical surface, as shown in Fig. 3.

4. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Rogler (U.S. 5,465,501).

Rogler discloses a gage 36, as shown in Fig. 2, for measuring the inside diameter of a brake drum, the gage 36 having:

- a fixed jaw 26 with a point 32 for measuring the maximum diameter at a point at one location along the friction surface of the drum;
- a movable jaw 30 with a point 34 for measuring the maximum diameter at the same distance from the edge of the friction surface; and
- stops 26d-26g, 30d-30g to keep the two opposed points 32, 34 the same distance along the friction surface of the drum.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogler (U.S. 5,465,501).

Rogler discloses all the subject matter claimed above in paragraph 3 with the exception of the specific range of distance between the stops, and the specific distance from the stop closest to a measuring point.

With respect to the specific range of distance between the stops: Rogler discloses a gage having movable stops 26d-26g, 30d-30g. The stops are spaced at predetermined distances from the points 32, 34. The spacing between adjacent pairs of stops may depend on the length of the jaws; for example, if the jaws are 10 inches long, the incremental distance between adjacent pairs of stops can be approximately 2 inches. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a distance between the stops in the range of 20mm to 40mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. See *In re Aller*, 105 USPQ 233. Therefore, it would have been obvious to a person having

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ordinary skill in the art at the time the invention was made to provide a distance between the stops disclosed by Rogler of 40mm (1.6 inches, approximately 2 inches) since Rogler is suggesting the desirability of that distance.

With respect to the specific distance from the stop closest to a measuring point: Rogler discloses a gage having movable stops 26d-26g, 30d-30g and the stops are spaced at predetermined distances from the points 32, 34. To choose at least 20 mm distance from the stop to the closest measuring point, is only considered to be the “ optimum ” value of distance from the stop to the closest measuring point, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to position the stop closest to a measuring point, disclosed by Rogler, at a distance of at least 20mm since that would be a preferred distance based on experimentation.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Victor et al. ('357), Owens, Drenner, and Johnson disclose related calipers.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243.

The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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